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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/993,696	12/18/97	SCHANZLIN	D 251692002821

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QM31/0624

EXAMINER	
WILLSE, D	
ART UNIT	PAPER NUMBER
3738	

DATE MAILED:

06/24/99

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/993,696

Applicant(s)

SCHANZLIN et al.

Examiner

Dave Willse

Group Art Unit

3738



☒ Responsive to communication(s) filed on Dec 18, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-67 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-67 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-49 and 65-67, drawn to an intracorneal insert, classified in class 623, subclass 5.
- II. Claims 50-64, drawn to a procedure for introducing an insert or a gel into a cornea, classified in class 623, subclass 5.

(Note: It is assumed that claims 58-60 should depend from claim 57 rather than from claim 45.)

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process as set forth in present claim 50 can be practiced with an insert having a radius of curvature *less than* 5.0 mm (in contrast with claims 1 and 36) or having a length *greater than* 2.5 mm (as opposed to the range of lengths recited in claim 41) or having a shape other than those specified in instant claims 65 and 67.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter and required searches, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

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General Designs of Intracorneal Inserts

Genus Ia	Figures 3A and 18
Genus Ib	Figures 4A, 5A, and 5B
Genus Ic	Figures 4B, 6A, 6B, and 16
Genus Id	Figures 4C and 17
Genus Ie	Figures 7A and 7B
Genus If	Figures 8A and 8B

Form Specifics for the Intracorneal Insert

Species IIa	Figure 9
Species IIb	Figure 10
Species IIc	Figure 11
Species IId	Figure 12
Species IIe	Figure 13
Species IIf	Figure 14
Species IIg	Figure 15

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species by selecting one entry from each of the two lists above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, the Applicant may

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elect Species (Ib, Iib), which involves the design of Figures 4A, 5A, and 5B, with a pre-formed curvature, a hexagonal cross-section, and non-tapered ends.

In the event that Invention II (procedures for introducing) is chosen from the above restriction requirement, the Applicant must additionally select from among the various species of procedures disclosed: Figures 21A-21D; Figures 22A-22C; Figures 23 and 24; Figures 25A-25C; and Figures 31A-31C.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, **and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species (MPEP § 809.02(a)).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The supervisory patent examiner is Mickey Yu, whose telephone number is (703) 308-2672. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
June 22, 1999


DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738